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Remarks

Restriction Requirement/35 U.S.C. §121

Restriction was made between the inventions of Group I, claims 1-41, 43 and 60-70 drawn to a process of forming a magnetic assembly, and Group II, claims 42 and 44-59, drawn to an article capable of adhering to a magnetic metal surface.

During a telephone conversation with Examiner Vivek Koppikar on May 27, 2003, Applicants provisionally elected with traverse to prosecute the invention of Group I, claims 1-41, 43 and 60-70. Applicants hereby affirm this election.

The Examiner has withdrawn claims 42 and 44-59 from further consideration.

Objections

Specification

The disclosure is objected to. The Office Action asserts that the amendment filed August 9, 2002 inserts the heading "Cross Reference to Related Applications" which was already in the specification, and adds the reference to priority of Application Serial Number 09/990,109."

Applicants believe this to have been added in the Preliminary Amendment filed April 30, 2002. Applicants have deleted this paragraph.

Claims

The Examiner has renumbered claims 70 and 71 as claims 69 and 70.

Claim 43 is objected to because the Office Action asserts that the recitation of "substage" in line 1 should be -substrate--.

Applicants have canceled claim 43.

Applicants respectfully request that these objections be withdrawn.

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Rejections

35 U.S.C. §112, first paragraph

Claim 62 has been rejected under 35 U.S.C. §112 as failing to comply with the written description requirement in that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one of skilled in the relevant art that the inventors(s), at the time the application was filed, had possession of the claimed invention.

Claim 62 has been canceled.

35 U.S.C. §112, second paragraph

Claims 2, 3, 6, 62 and 63 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 62 and 63 have been canceled.

The Office Action asserts that claims 2 and 3 should be amended to recite --said applying step c)-- rather than "said applying step b)". Claims 2 and 3 have been amended accordingly. Applicants respectfully request withdrawal of the rejection of claims 2 and 3 under 35 U.S.C. §112, second paragraph.

The Office Action asserts that claim 6 is unclear by reciting said magnetic composition has cooled to ambient temperature and suggests amend to --said magnetic composition is cooled to ambient temperature--.

Applicants have amended claim 6 to recite --said magnetic composition is at ambient temperature. The act of cooling may simply involve allowing the composition to sit at ambient temperature until it has sufficiently cooled.

Applicants respectfully request withdrawal the rejection of claim 6 under 35 U.S.C. §112, second paragraph.

35 U.S.C. §102(b)

Claims 1-4, 6-9, 14-16, 18, 22-26, 29-31, 38-40, 43, 60-65, 68 and 69 have been rejected under 35 U.S.C. §102(b) as being anticipated by Silverschotz et al. (U.S. Patent No. 5,869,148). The Office Action asserts that Silverschotz et al. disclose a method of forming a

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magnetic assembly by providing a molten magnetic composition comprising at least one magnetic material and at least one thermoplastic binder (col. 2, lines 19-27), forming the magnetic composition (601) into the magnetic layer at an elevated temperature (using a hot melt polymer; col. 3, line 22), and directly applying the magnetic layer at an elevated temperature when it is pliable to a printable substrate layer (web 200) (the hot melt composition is coated onto the substrate layer).

Claims 1 and 60 are directed to a process of forming a magnetic assembly whereby a magnetic composition is applied directly to a printable substrate layer at an elevated temperature. Claims 1 and 60 have further been amended to incorporate specific polymer materials for the thermoplastic binder. These polymers are found in claims 18 and 65 respectively which have been canceled.

Claims 1 and 60 as amended are not anticipated by Silverschotz et al. Silverschotz et al. do not specifically teach any hot melt polymers which can be used in a in the process described therein. In fact, the only thing suggested by Silverschotz et al. to employ in a hot-melt binder is a wax, which has very different physical properties than a polymer.

Claims 2-4, 6-9, 14-16, 18, 22-26, 29-31 and 38-40 depend from claim 1 and are not anticipated by Silverschotz et al. for at least the reasons that claim 1 is not anticipated.

Claims 43 and 60-65, 68 and 69 have been canceled.

New claims 71-74 have been added.

Support for claim 71 is found on pages 6 and 7.

Support for claims 72 and 73 is found on page 4.

Support for claims 75-76 is found from original claim 11 and page 19.

No new matter has been added.

Applicants believe claims 71-76 to be patentably distinct over Silverschotz et al.

Applicants respectfully request withdrawal of the rejection of claims 1-4, 6-9, 14-16, 22-26, 29-31 and 38-40 under 35 U.S.C. §102(b) as being anticipated by Silverschotz et al.

35 U.S.C. §103(a)

Claims 1-4, 6-9, 14-16, 18, 22-26, 29-31, 38-40, 43, 60-65, 68 and 69 have been rejected under 35 U.S.C. §103(a) as being obvious over Silverschotz et al. (U.S. Patent No.

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5,869,148) as applied to claims 1 and 61 above, and further in view of Sawa et al. (U.S. Patent No. 4,022,701).

Claims 1 and 60 have been amended to incorporate the limitations of claims 18 and 65 respectively which have been canceled as described above.

Silverschotz et al. describe a process for in-line, high speed manufacturing of magnetic products including the steps of printing onto a substrate, drying the ink print, making the appropriate cuts or scores on the substrate, applying a slurry of magnetizable material onto the substrate to create the magnet, drying the applied material, magnetizing the magnetic material and cutting and forming the substrate to the desired dimensions. (Abstract). The slurry is described at col. 3, lines 19-57.

Applicants submit that Silverschotz et al. do not disclose specific hot-melt polymers as recited in amended claims 1 and 60. In fact, Silverschotz et al. appear to equate the hot-melt polymer or binder therein with the wax. See col. 3, lines 34-36. Silverschotz et al. give no further direction whatsoever, as to any particular hot melt binder. This would lead one to believe, at a minimum, that the system is high in wax content, without being able to determine if there are any other ingredients in the hot melt binder system, as no further direction is provided.

Waxes are, to one of ordinary skill in the hot melt adhesive art, in a category separate from thermoplastic polymers. Waxes have, for one thing, viscosities which are much lower than that of a polymer, and in fact are used to modify viscosity and rate of set of the hot melt systems. Furthermore, the high amount of hot melt binder suggested by Silverschotz et al., 30-60% (col. 3, lines 26-27) is more consistent with the use of a high wax content hot melt system. The more wax a system has, the lower the viscosity.

Applicants submit that Silverschotz et al., do not specifically teach or suggest the use of any thermoplastic polymers for use in the process described therein. The general reference to hot melt polymer binder systems does not provide adequate teaching or motivation to one of skill in the art to pick any thermoplastic polymers found in amended claims 1 and 60 of the present invention for use in the process described therein. Furthermore, at one point, Silverschotz et al. equates a hot melt binder with a wax. (See col. 3, lines 34-36). Consequently, it is unclear as to what the teaching is.

Sawa et al. describe an anisotropic plastics magnet having a maximum energy

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product (BH)max not lower than 0.9 MG Oe, a remanence Br not lower than 2000G and a coercive force Hc not lower than 1800 Oe, and being composed at least one of ferromagnetic powders having a large magnetic anisotropy constant and at least one selected from the group consisting of metal-cross-linked copolymers of alpha-olefin and alpha,beta unsaturated mono- or dicarboxylic acid and saponified copolymers of ethylene and vinyl acetate, the axis of the easy magnetization of said ferromagnetic powders being oriented substantially in one direction, and a process for producing the same comprising mixing the ferromagnetic powder and the resin and forming the mixture under heating while a magnetic field is being applied. (Abstract).

Applicants submit that Sawa et al. describe a composition which includes a specific polymer combination for *molded* magnets, not for printing applications.

Furthermore, the compositions suggested by Sawa et al. do not include a wax, and the examples found at col. 5 and 6 of Sawa et al. have, at most, 12% of a polymer with the remainder being ferrite powder, an amount of polymer which is far outside the range suggested by Silvershotz et al. Furthermore, Sawa et al. indicate that the forming properties of a fair number of their formulas are bad or only slightly good.

As discussed above, Silverschotz et al. suggest the polymer be used in amounts of 30-60% by weight of the mixture. Silverschotz et al. suggest no specific polymers, and in fact only suggest the use of a wax. At one point, Silverschotz et al. appear to be using the term wax, interchangeably with that of the binder. (Col. 3, lines 34-36). From this statement it would appear at the very least that Silverschotz et al. contemplates hot melts having a high wax content for use in the printing process described therein as discussed above.

There is thus nothing in the combination of these references that would suggest to one of ordinary skill in the art that the composition as found in Sawa et al. for injection molding magnets, could be employed in the in-line printing process described in Silverschotz et al.

In specific reference to claims 18-20, the Office Action asserts on page 8, that the selection of such well known and available thermoplastic materials for a binder in a magnetic layer is considered conventional and obvious to one of ordinary skill in the art, and that furthermore, Sawa discloses such compositions.

Applicants submit that if this is true, it is only true with respect to the methods by which magnetic materials are typically formed, which is by molding and calendaring, and

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wherein at a later time, they are adhered to a substrate through the use of an adhesive layer, and not in a single in-line process as found in Silverschotz et al. Thus, it would not be obvious to select such polymers for use in the process of Silverschotz et al.

Applicants submit that the examiner is using a hindsight analysis, whereby the knowledge and teaching of the present invention, is being employed.

Applicants submit that based on the foregoing, claims 1 and 60 are not obvious over Silverschotz et al., and further in view of Sawa et al.

Claims 2-4, 6-9, 14-16, 22-26, 29-31 and 38-40 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Based on the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1-4, 6-9, 14-16, 18-20, 22-26, 29-31 and 38-40 as being obvious over Silverschotz et al., US 5869148, and further in view of Sawa et al., US 4022701.

Claims 10-13, 16, 18-20, 22-24, 27 and 64-70 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701).

Claims 18 and 64-70 have been canceled.

Claims 10-13, 16, 19-20, 22-24 and 27 depend from claim 1 and are patentable over Silverschotz et al. and optionally Sawa et al., at least for the reasons discussed above.

Applicants respectfully request withdrawal of the rejection of claims 10-13, 16, 18-20, 22-24, 27 and 64-70 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701).

Claim 5 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701), and further in view of Ripplingale et al. (US 5114517). The Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by Silverschotz et al. and optionally Sawa et al. by subjecting the assembly to a magnetic field while the extruded layer is at an elevated temperature in order to provide a magnetic effect in the assembly while the magnetic particles can still be aligned as shown by Ripplingale et al. (US 5114517).

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Silverschotz et al. and Sawa et al. have been discussed above.

Rippingale et al. describes a magnetic marker serving to locate, trace, and identify an elongated hidden object, such as a buried utility pipe, duct, conduit, or fiber optic cable, which is manufacture by applying magnetic material to a substrate that is elongated and by forming from the material a helical or twisted permanent magnet pattern extending along the length of the substrate. (Abstract).

Claim 1 has been amended as discussed above and is patentable for at least the reasons discussed above.

Further combining Rippingale et al. with Silverschotz et al. and Sawa et al. does not lead one of ordinary skill in the art to the invention of claim 1 as discussed above. Claim 5 depends from claim 1 and is patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claim 5 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701), and further in view of Rippingale et al. (US 5114517).

Claims 28, 39 and 41 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701), as applied to claim 1 and further in view of Martin (US 5458282). The Office Action asserts that it is unclear if Silverschotz et al. discloses the magnetic layer is of the same width as the printable layer.

Silverschotz et al. and Sawa et al. have been discussed above.

Martin describe a card fabricated of a flexible material such as paper, pasteboard, plastic and the like that has a first planar surface and a second planar surface. The card is formed with a line of perforations or a fold line dividing the card into first and second sections and a thin, flexible, magnetic sheet material is adhesively secured to one of the planar surfaces of one of the sections. The thin, flexible, magnetic sheet is dimensionally coextensive with the section to which it is attached. Indicia is printed on the exposed surface of the card section to which the magnetic sheet is secured. The Office Action uses Martin to show that it is known to provide a magnetized layer that has the same width as the printable layer.

Claims 28, 39 and 41 depend from claim 1. Claim 1 has been amended and is patentable for at least the reasons discussed above. Claims 28, 29 and 41 are patentable for at

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least the reasons that claim 1 is patentable.

Combining the cards of Martin with Silverschotz et al. and optionally Sawa et al., does not lead one of ordinary skill in the art to the present invention.

Applicants respectfully request withdrawal of the rejection of claims 28, 39 and 41 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701), as applied to claim 1 and further in view of Martin (US 5458282).

Claims 32-36 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa (US 4022701) as applied to claim 1 above, and further in view of Schramer et al. (US 5019436). The Office Action asserts that Schramer discloses an example of a well known advertising concept of temporarily adhering coupons/marketing articles to a release layer that is adhesively attached to a product article, such as packages, containers, etc. to allow removal of the marketing article from the product article.

Silverschotz et al. and Sawa et al. have been discussed above.

Claim 1 is patentable over Silverschotz et al. and Sawa et al. for at least the reasons discussed above.

Claims 32-36 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Combining the advertising concept of Schramer et al. with Silverschotz et al. and Sawa et al. does not lead one of ordinary skill in the art to the present invention.

Applicants respectfully request withdrawal of the rejection of claims 32-36 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa (US 4022701) as applied to claim 1 above, and further in view of Schramer et al. (US 5019436).

Claim 37 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701) and Schramer et al. (US 5019436), as applied to claim 32 above, and further in view of Martin (S 5458282), Fosbenner et al. (US 5949050) and/or Mack (US 46218327).
Silverschotz et al., Sawa et al., Schramer et al. and Martin have been discussed above.

The Office Action employs Martin, Fosbenner et al. and Mack to show that it is

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known to perforate an overlamine in the same dimensions as an underlying member in order to allow the overlamine to provide protection to the underlying member until a consumer tears the overlamine at the perforations in order to use the underlying member.

Claim 1 as amended is patentable for at least the reasons discussed above.

Combining the above-listed references with Silverschotz et al. and Sawa et al. does not lead one of ordinary skill in the art to the present invention.

Claim 37 depends from claim 1 and is patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claim 37 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US 5869148) and optionally Sawa et al. (US 4022701) and Schramer et al. (US 5019436), as applied to claim 32 above, and further in view of Martin (S 5458282), Fosbenner et al. (US 5949050) and/or Mack (US 46218327).

Claims 61-64 and 68-70 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson (US 5983537) and/or Martin (US 5458282) in view of Breen et al. (US 5879784).

Claims 61-64 and 68-70 have been canceled.

Claims 1-3, 8-41, 43, 60 and 64-67 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson (US 5983537) and/or Martin (US 5458282) in view of Breen et al. as applied to claim 61, above, and further in view of Sawa et al (US 4022701). The Office Action asserts that Johnson discloses a method of forming a magnetic assembly with a magnetic layer (magnet 24) and a printable substrate layer (substrate 20) and that Martin discloses a method of forming a magnetic assembly with a magnetic layer (magnetic sheet material 24) and a printable substrate layer (section 20).

The Office Action further asserts that both Johnson and Martin disclose adhesively securing the magnetic layers, but that it is well known in the art that an alternative to adhesively securing a magnetic layer to a substrate is to apply the magnetic layer directly onto the substrate.

Applicants disagree.

Claims 1 and 60 are discussed above.

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Johnson, US 5983537

Johnson describes a card device which may be supported on a refrigerator or other metallic objects by magnetic coupling thereto. The card device is preferably made in the form of a mailable postcard or otherwise a greeting card or an announcement card. In the case of an announcement card and postcard, a single substrate is employed and a magnetic film is adhesively secured to an upper face of the substrate. A second substrate or otherwise a portion of the first substrate may be folded over and placed facewise upon the second substrate and adhesively secured thereto. The magnetic film is thereby captured between the two plies. In the preparation of a greeting card, a substrate may be folded into three different panels with one panel being folded over the next adjacent panel and attached thereto with a magnetic film secured therebetween, again usually by adhesives. A message may be then presented on any of the exposed faces of the panels. In addition, individual strips of the magnetic film may be employed. (Abstract).

Applicants assert that there is in fact nothing in Johnson which would suggest direct application of the flexible magnet described therein at an elevated temperature to a printable substrate.

Furthermore, Applicants assert that the standard in the industry is to form the magnet at one time, and then adhesively secured to the substrate at a later date. Applicants assert that it is in fact, this type of process which is described by Johnson.

Applicants assert that the Examiner is using improper hindsight analysis using the present invention in order to suggest (page 13, 2nd paragraph of the Office Action) that it is well known in the art to apply the magnetic composition at an elevated temperature, or extruding it directly onto the substrate. The statement in Johnson that the Examiner relies on to make this statement is found at col. 1, lines 15-23 and is the following:

In recent years, flexible and bendable magnetic films have been commercially available. These films usually include a substrate, such as a cellulose substrate, e.g., a paper substrate, with magnetic material either coated on the substrate or otherwise applied thereto. The substrate with the metallic and magnetically prepared material thereon will then function as a permanent magnetic. One such form flexible magnetic is offered by Magnetic Specialty, Inc. of Murietta, Ohio.

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Applicants submit that there is nothing in this statement to suggest that "coating or otherwise applying thereto", includes direct application of the magnetic material to the substrate at an elevated temperature, and that it is improper for the Examiner to do so. The analysis which the Examiner is using in order to do this, is based on an improper hindsight analysis, using the teachings of the present invention. This is not permissible. See *In re Geiger*, 815 F.2d 686, 688; 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). "That [the prior art] might incorporate elements which could be used in appellants' system does not render appellants' claims obvious when there is no suggestion of using these elements in substantially the same manner as appellants use them." *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) (the prior art did not teach "how to solve the problems" faced by the inventor); *In re Hortman*, 264 F.2d 911, 913, 121 USPQ 218, 219 (CCPA 1959). "When determining obviousness, "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985).

Breen, US 5879784

Breen describes documents having a thin reflective extruded security stripe comprising a leafing aluminum pigment having a gloss characteristic of from 20 to 24 as measured on a Gardner/BYK Microglass meter at a 60° angle.

The security stripe as described in Breen et al. is applied out of a solvent, i.e. acetone. See the example shown at col. 3, lines 48-57. Extrusion does not have to be done at elevated temperatures, and there is no suggestion by Breen in fact, to employ elevated temperatures. Thus, while Breen et al. refers to extrusion, there is no suggestion that they are extruding a thermoplastic composition at an elevated temperature. In fact, the teaching is that the binder and aluminum particulate matter is applied out of solvent. Furthermore, the tickets described by Breen et al. provide no magnetic capability and it cannot be predicted that such a thin layer of magnetic material would provide enough magnetic strength.

Thus, combining Breen with Johnson et al., does not lead one of ordinary skill in the art to direct application of a magnetic composition to a printable substrate in one single

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process using extrusion at an elevated temperature.

Martin, US 5458282

Martin describes a card fabricated of a flexible material such as paper, pasteboard, plastic and the like that has a first planar surface and a second planar surface. The card is formed with a line of perforations or a fold line dividing the card into first and second sections and a thin, flexible, magnetic sheet material is adhesively secured to one of the planar surfaces of one of the sections. The thin, flexible, magnetic sheet is dimensionally coextensive with the section to which it is attached. Indicia is printed on the exposed surface of the card section to which the magnetic sheet is secured.

The magnetic material suggested for use at col. 3, lines 24-29 is manufactured by Flex-Mag, a division of Dynacast Co. in Marietta Ohio and available under the tradename of ULTRAMAG. These magnets are manufactured by one company, and then later applied with an adhesive while at ambient temperatures to a substrate. Information from their internet website has been included herewith. The process described in Martin is thus different process from the embodiments in claims 1 and 60 in that the magnetic material is not directly applied to the printable substrate at an elevated temperature. Martin therefore also describes a more complex multistep process. Such processes have in fact been an industry standard. The brochure illustrates pictures of the magnetic products produced by Flex-mag Industries, Inc.

Breen is discussed above. Neither Martin nor Breen suggest direct application of the magnetic composition to a substrate at an elevated temperature in a single process, nor can the Examiner improperly read such a teaching into these references as discussed above.

Sawa et al. describe flexible magnets formed by injection molding using specific compositions as described above.

The combinations of Johnson and/or Martin and Breen, therefore all lack elements of the inventions found in claims 1 and 60. Claims 2-3, 8-41 and 43 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Using the compositions of Sawa et al. in any of these processes, does not lead one of ordinary skill in the art to the present invention because none of Johnson, Martin, or Breen, describe direct application of a magnetic composition at an elevated temperature to a substrate in

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a single process.

Applicants respectfully request withdrawal of the rejection of claims 1-3, 8-41, 43 and 60 under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin, in view of Breen et al. as applied to claim 61, above, and further in view of Sawa et al. (US 4022701).

Claims 4-7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa et al. as applied to claim 1 above, and further in view of Rippingale et al. (US 5114517).

The Office Action asserts that Rippingale et al. disclose subjecting an extruded magnetic layer to a magnetic field in order to provide a magnetic effect in the assembly (col. 3, lines 10-28) and that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming a magnetic assembly as shown by the references above by subjecting the assembly to a magnetic field in order to provide a magnetic effect in the assembly.

Claim 1 is patentable for the reasons described above. Claims 4-7 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claims 4-7 under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa et al. as applied to claim 1 above, and further in view of Rippingale et al. (US 5114517).

Claims 32-36 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa et al. as applied to claim 1 above, and further in view of Schramer et al. (US 5019436).

The Office Action asserts that Schramer et al. disclose an example of a well known advertising concept of temporarily adhering coupons/marketing articles to a release layer that is adhesively attached to a product article, such as packages, containers, etc. to allow removal of the marketing article from the product article.

Johnson, Martin, Breen et al. and Sawa et al. have been discussed above. Claim 1 is patentable for at least the reasons discussed above. Claims 32-36 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claims 32-36 under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and

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Sawa et al. as applied to claim 1 above, and further in view of Schramer et al. (US 5019436).

Claim 37 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa et al. and Schramer et al. as applied to 32 above, and further in view of Martin '624 (5924624), Fosbenner et al. (5949050) and/or Mack (US 4621837).

The Office Action asserts that it is well known in the art to perforate an overlamine in the same dimensions as an underlying member in order to allow the overlamine to provide protection to the underlying member until a consumer tears the overlamine and the perforations in order to use the underlying member.

Claim 1 is patentable for at least the reasons discussed above. Claim 37 depends from claim 1 and is patentable for at least the reasons that claim 1 is patentable. Applicants respectfully request withdrawal of the rejection of claim 37 under 35 U.S.C. §103(a) as being unpatentable over Johnson and/or Martin in view of Breen et al. and Sawa et al. and Schramer et al. as applied to 32 above, and further in view of Martin '624 (5924624), Fosbenner et al. (5949050) and/or Mack (US 4621837).

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CONCLUSION

Claims 1-17, 19-41, 60 and 71-76 are pending in the application. Claims 18, 43-44 and 61-70 have been canceled. Claims 42 and 45-59 have been withdrawn from consideration. Applicants have addressed each of the issues presented in the Office Action. Based on the foregoing, Applicants respectfully request reconsideration and an early allowance of the claims as presented.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: December 11, 2003

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